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LAW OFFICES OF JONATHAN ALAN QUINE

By: _____

Chianti Appling

Atty Docket No: 300-903820US

Election/Ext(4)/#23

4.30.02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

**AKIRA KOMORIYA and BEVERLY
PACKARD**

Application No.: 09/394,019

Filed: 09/10/1999

For: **COMPOSITIONS FOR THE
DETECTION OF ENZYME ACTIVITY IN
BIOLOGICAL SAMPLES AND METHODS
OF USE THEREOF**



Examiner: Chih Min Kam

Art Unit: 1653

**RESPONSE TO RESTRICTION
REQUIREMENT**

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is filed in response to the Office Action dated November 21, 2001 containing a Restriction Requirement. The following documents are enclosed herewith:

- 1) A petition to extend the period of response for four months.

REMARKS

In the November 21, 2001 Office Action the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

- Group I: Claims 1-15, drawn to a fluorogenic composition for the detection of the activity of a protease; and
- Group II: Claims 16-26, drawn to a method of detecting the activity of a protease;

In response to this restriction requirement, Applicants provisionally elect Group I, claims 1-15, with traverse.

Applicants submit that restriction between Groups I and II is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, **even though they are directed to distinct inventions**, unless to do so would create a serious burden. In the instant case, the claims of Group I are directed particular fluorogenic protease indicators, while the claims of

Group II are directed to methods using those same fluorogenic protease indicators. A search for prior art relevant to the compositions claimed in Group I is expect to identify any prior art, if such exists, relevant to the use of those same compositions. Accordingly, a search and examination of Groups I and II together requires no greater burden than a search and examination of Group I, alone. A search and examination of Groups I and II, together, therefore does not create a "serious burden".

Accordingly, in light of M.P.E.P. §803, the restriction between Groups I and II should be withdrawn.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

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Respectfully submitted,



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